

This Opinion is Not a
Precedent of the TTAB

Mailed: May 18, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Education First, Inc.
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Serial No. 87875275
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Peter A. Koziol of Assouline & Berlowe, P.A. for Education First, Inc.

Maureen J. Reed, Trademark Examining Attorney,¹ Law Office 115,
Daniel S. Brody, Managing Attorney.

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Before Rogers, Chief Administrative Trademark Judge, and Wellington and Larkin,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

Education First, Inc. (“Applicant”) seeks registration on the Principal Register of the standard-character mark VESS for services in International Class 41 ultimately identified as follows:

Educational services, namely, conducting programs in the field of preschool education; Educational services, namely, conducting programs in the field of elementary school

¹ A different Trademark Examining Attorney examined the involved application prior to appeal, and issued the final refusal to register from which Applicant appealed. The application was assigned after appeal to Ms. Reed, who filed the brief of the United States Patent and Trademark Office (“USPTO”). In this opinion, we will refer to both Ms. Reed and her predecessor as the “Examining Attorney.”

education; Educational services, namely, conducting programs in the field of middle school education; Educational services, namely, conducting programs in the field of high school education; Educational services, namely, developing curriculum for teachers; Arranging and conducting educational conferences; Developing educational lesson plans for others in the field of preschool education; Developing educational lesson plans for others in the field of elementary school education; Developing educational lesson plans for others in the field of middle school education; Developing educational lesson plans for others in the field of high school education; Education services, namely, providing tutoring in the field of preschool education; Education services, namely, providing tutoring in the field of elementary school education; Education services, namely, providing tutoring in the field of middle school education; Education services, namely, providing tutoring in the field of high school education; Education services, namely, providing pre-kindergarten through 12th grade (pre-K-12) classroom instruction; Information in the field of parenting concerning education of children; Personal coaching services in the field of preschool education; Personal coaching services in the field of elementary school education; Personal coaching services in the field of middle school education; Personal coaching services in the field of high school education.²

The Examining Attorney has refused registration of Applicant's mark on the ground that it is "primarily merely a surname" within the meaning of Section 2(e)(4) of the Trademark Act, 15 U.S.C. § 1052(e)(4).³ When the Examining Attorney made

² Application Serial No. 87875275 was filed on April 12, 2018 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Applicant's claim of first use of the mark at least as early as September 7, 2011 and first use of the mark in commerce at least as early as September 8, 2011, and under Section 44(e) of the Trademark Act, 15 U.S.C. § 1126(e), based on Applicant's Colombian Registration No. 507534. Applicant entered a miscellaneous statement that reads as follows: "VESS is an acronym of Vida Equilibrada con Sentido y Sabiduría, which translates from Spanish to English as, 'Balanced life with sense and wisdom.'" Applicant's claim to registration under Section 44(e) was subsequently withdrawn.

³ As discussed below, registration was finally refused on the additional ground of likelihood of confusion under Section 2(d) of the Trademark Act, but following the first remand of the application to the Examining Attorney after Applicant appealed, the Examining Attorney

the refusal final, Applicant appealed and requested reconsideration, which was denied. Applicant and the Examining Attorney have filed briefs.⁴

As discussed in more detail below, Applicant ultimately amended its application to seek registration, in the alternative, based on acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), and the Examining Attorney has accepted this alternative claim.

We affirm the surname refusal to register. Applicant's application, as amended to seek registration under Section 2(f), will be published for opposition.

I. Prosecution and Procedural History⁵

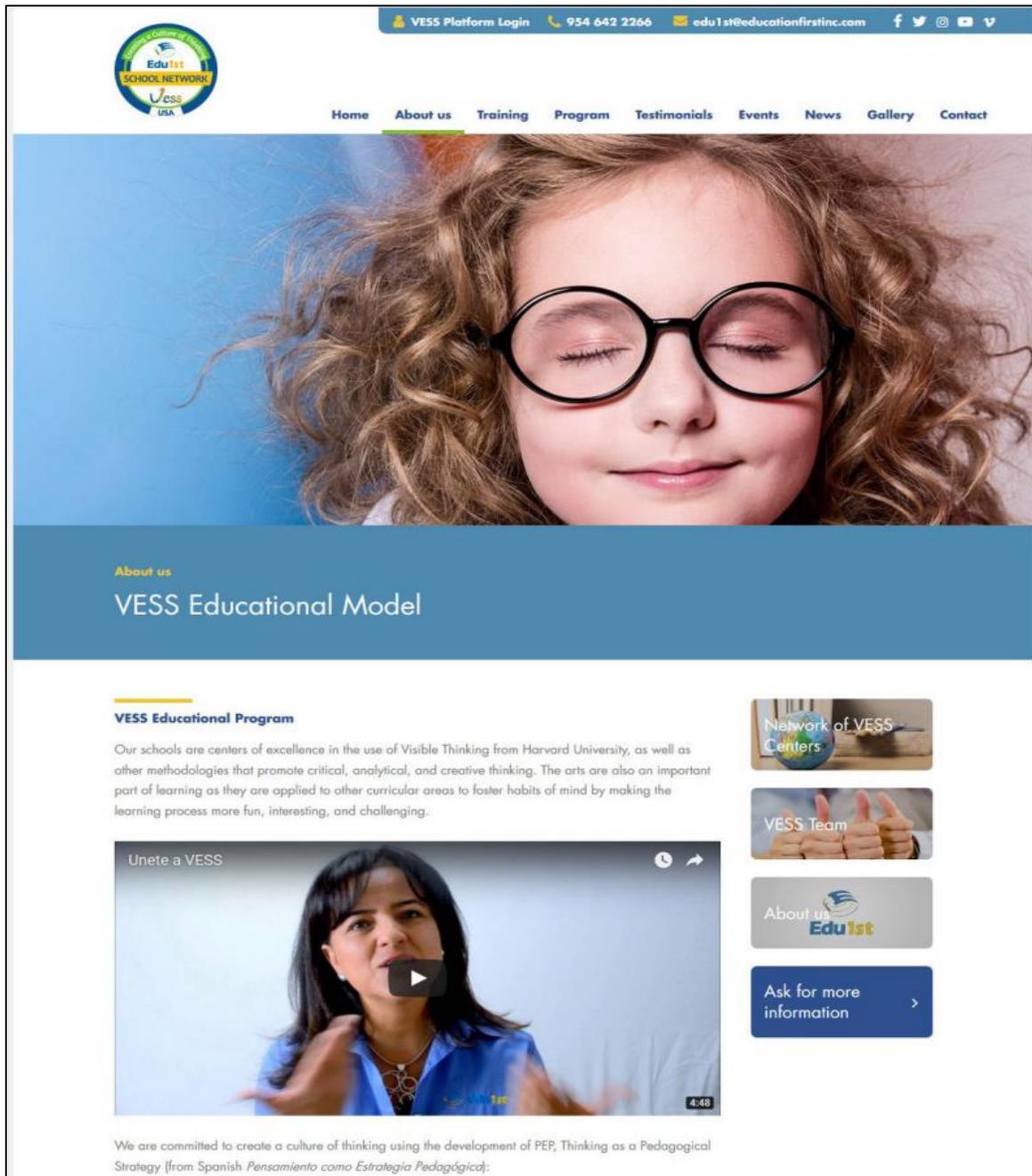
This appeal has travelled to us for final decision on a long and winding road. We summarize below the prosecution history of the application and the procedural history of the appeal because they provide useful background to our disposition of the appeal.

withdrew that refusal, December 31, 2020 Final Office Action at TSDR 1, and only the surname refusal is before us for decision.

⁴ Citations in this opinion to the briefs and other materials in the case docket refer to TTABVUE, the Board's online docketing system. *See New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ 10596, at *2 n.1 (TTAB 2020). The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. Applicant's supplemental brief, which is its operative brief for the reasons discussed below, appears at 24 TTABVUE. The Examining Attorney's brief appears at 26 TTABVUE.

⁵ Citations in this opinion to the application record, including the request for reconsideration and its denial, are to pages in the USPTO's Trademark Status and Document Retrieval ("TSDR") database.

Applicant initially sought registration of its proposed mark VESS for a host of educational services based on a specimen of use consisting of a page from its website, a portion of which is reproduced below:



⁶ April 12, 2018 Application at TSDR 26.

The Examining Attorney issued a first Office Action refusing registration on two grounds: (1) under Section 2(d), on the ground that Applicant's proposed mark so resembles the registered mark VES as to be likely to cause confusion, and (2) under Section 2(e)(4) on the ground that VESS is primarily merely a surname.⁷ The Examining Attorney referred in the body of the office action to "evidence show[ing] the applied-for mark appearing 2090 times as a surname in the LEXISNEXIS® surname database,"⁸ but no such evidence was attached. The Examining Attorney noted that Applicant could make a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), to overcome the surname refusal.⁹

Applicant allowed its application to become abandoned, but successfully petitioned to revive it, arguing against both refusals and making of record the Declaration of Santiago Carrillo ("Carrillo Decl."), Applicant's Chief Development Officer, purportedly in support of a claim of acquired distinctiveness under Section 2(f).¹⁰ Mr. Carrillo stated that the proposed mark had been used substantially exclusively and continuously in the United States in connection with the services identified in the application since September 2011.¹¹ He also stated that "VESS as used by Applicant is not a surname," that "[n]o one connected with Applicant uses

⁷ August 12, 2018 Office Action at TSDR 1. Because the Section 2(d) refusal was withdrawn, we will not summarize the evidence made of record by Applicant and the Examining Attorney directed to that refusal.

⁸ *Id.*

⁹ *Id.*

¹⁰ February 27, 2019 Petition to Revive at TSDR 6-9.

¹¹ *Id.* at TSDR 7 (Carrillo Decl. ¶¶ 2-3).

VESS as a surname,” and that Applicant “does not use VESS in conjunction with other given names or in a manner that would suggest that it is a surname.”¹²

The Examining Attorney next issued a Final Office Action maintaining both refusals to register.¹³ The Examining Attorney made of record pages from online dictionaries,¹⁴ pages from ancestry.com,¹⁵ and USPTO electronic records.¹⁶

The Examining Attorney then sua sponte issued a Subsequent (second) Final Office Action. The Examining Attorney stated that Applicant’s “Section 2(f) claim is acceptable and has been entered into the application record,” and that “[f]or this reason the surname refusal is *withdrawn*.”¹⁷ The sua sponte Subsequent Final Office Action also confirmed Applicant’s deletion of the Section 44 basis for registration and maintained and made final the Section 2(d) refusal to register.¹⁸

Applicant appealed and requested reconsideration. In its Request for Reconsideration, Applicant argued against the Section 2(d) refusal and, apparently reluctant to accept the withdrawal of the surname refusal, argued against that refusal as well, claiming that “VESS used by Applicant is not a surname and does not require registration under section 2(f).”¹⁹

¹² *Id.* at TSDR 8 (Carrillo Decl. ¶¶ 12-14).

¹³ March 30, 2019 Final Office Action at TSDR 1.

¹⁴ *Id.* at TSDR 2-7, 8-9.

¹⁵ *Id.* at TSDR 10-33.

¹⁶ *Id.* at TSDR 34-36.

¹⁷ July 31, 2019 Subsequent Final Office Action at TSDR 1 (emphasis supplied by the Examining Attorney).

¹⁸ *Id.*

¹⁹ January 28, 2020 Request for Reconsideration at TSDR 7.

Applicant argued against the merits of the withdrawn surname refusal,²⁰ and “request[ed] that examiner [sic] allow registration of the mark as inherently distinctive and not require acquired distinctiveness under § 2(f).”²¹ Applicant made of record another copy of the Carrillo Declaration,²² pages from the website of the National Center for Education Statistics,²³ pages from Applicant’s website,²⁴ and third-party registrations of VES and VESS marks for various goods and services.²⁵

The Examining Attorney then issued a third Final Office Action superseding the previous one. The Examining Attorney maintained the Section 2(d) refusal, reinstated the surname refusal given Applicant’s indication “that it in fact does not intend to assert a claim of acquired distinctiveness to overcome the surname refusal,” and stated that the “application record has been amended to delete the Section 2(f) claim.”²⁶

The appeal was resumed following the Examining Attorney’s issuance of the third Final Office Action, 6 TTABVUE 1, and Applicant filed its appeal brief, 15 TTABVUE, after obtaining four extensions of time to do so. 7-14 TTABVUE. The Examining Attorney then moved to remand the application “to submit additional evidence into the record relevant to the issue(s) on appeal,” 17 TTABVUE 2, “because a new

²⁰ *Id.* at TSDR 7-9.

²¹ *Id.* at TSDR 9.

²² *Id.* at TSDR 11-14.

²³ *Id.* at TSDR 15-21.

²⁴ *Id.* at TSDR 28-37.

²⁵ *Id.* at TSDR 38-69.

²⁶ February 25, 2020 Subsequent Final Office Action at TSDR 1.

trademark examining attorney has taken over the case and wishes to supplement the evidence of record to support the current refusal under Trademark Act Section 2(e)(4) that the applied-for mark is primarily merely a surname.” *Id.* at 3. The Board granted the motion, suspended the appeal again, and remanded the application to the Examining Attorney for submission of the additional evidence. 19 TTABVUE 2.

On remand, the Examining Attorney withdrew the Section 2(d) refusal, but maintained the Section 2(e)(4) refusal.²⁷ The Examining Attorney made of record a page from THE COLUMBIA GAZETTEER OF THE WORLD;²⁸ pages from the US Dictionary portion of the OXFORD ENGLISH DICTIONARY and the MERRIAM-WEBSTER DICTIONARY;²⁹ pages from a search of the Public Records portion of the LexisNexis database listing names, addresses, and phone numbers for persons with the surnames “Bess,” “Gess,” “Hess,” “Ness,” and “Ress;”³⁰ Internet webpages and articles showing or referring to persons with the surname “Vess;”³¹ the results of a search of linkedin.com stating that there were more than 1,000 results for “Vess” and including references to the LinkedIn pages of 47 people with the surname “Vess;”³² and a Wikipedia entry for one Charles Vess.³³

²⁷ December 31, 2020 Final Office Action at TSDR 1.

²⁸ *Id.* at TSDR 2.

²⁹ *Id.* at TSDR 3-4.

³⁰ *Id.* at TSDR 5-9.

³¹ *Id.* at TSDR 10-15, 23-24.

³² *Id.* at TSDR 16-22.

³³ *Id.* at TSDR 25.

The Board again resumed the appeal, and allowed Applicant to file a supplemental brief within 60 days of the Board’s order. 21 TTABVUE 1. Applicant did so, 24 TTABVUE,³⁴ and the Examining Attorney then filed her brief. 26 TTABVUE. Applicant then sought and received an extension of time to file a reply brief, 27-28 TTABVUE, but instead of doing so, Applicant filed a motion to remand the application so that Applicant could “further supplement the record” with evidence of “other meanings of VESS, which also have nothing to do with Applicant’s acronymic mark and are further cumulative evidence showing that VESS has a primary meaning other than as a surname” 29 TTABVUE 2. Applicant attached the referenced evidence to its motion, which consisted of definitions of the word “vess” from the Urban Dictionary (urbandictionary.com), *id.* at 5-7; a Wikipedia entry regarding Vess Soda, *id.* at 9; and pages from the websites of third parties that use VESS as an acronym or brand name. *Id.* at 11-41. The Board granted Applicant’s motion and remanded the application to the Examining Attorney “so that additional evidence may be introduced and made of record.” 30 TTABVUE 1.

³⁴ Applicant’s supplemental brief states that “[f]or convenience of the Board the documents [listed] below are included as an Appendix” to the brief. 24 TTABVUE 7, 21-125. The Board strongly discourages the practice of attaching record evidence to briefs. “Parties to Board cases occasionally seem to be under the impression that attaching previously-filed evidence to a brief and citing to the attachments, rather than to the original submission is a courtesy or convenience to the Board. It is neither.” *In re Michalko*, 110 USPQ2d 1949, 1950 (TTAB 2014). As the Board explained in *Michalko*, “[w]hen considering a case for final disposition, the entire record is available to the panel,” and “[b]ecause we must determine whether attachments to briefs are properly of record, citation to the attachment requires examination of the attachment and then an attempt to locate the same evidence in the record developed during the prosecution of the application,” which requires “more time and effort than would have been necessary if citations directly to the prosecution history were provided.” *Id.* at 1950-51.

On remand, the Examining Attorney acknowledged that “Applicant has provided additional evidence in its Request for Remand,” but found that Applicant’s “limited evidence of companies using the wording VESS in a proprietary and non-surname manner does not outweigh the substantial evidence that consumers would view the term as primarily merely a surname.”³⁵ The Examining Attorney made of record additional Internet webpages and articles from Lexis.com showing or referring to persons with the surname “Vess;”³⁶ pages from the DICTIONARY OF AMERICAN FAMILY NAMES listing the surname “Vess;”³⁷ pages from the website at Forebears containing a “Vess Surname Distribution Map;”³⁸ pages from the website of the United States Census Bureau regarding the frequency of the appearance of the “Vess” surname in the 2010 Census;³⁹ a page from the website at 4crests.com displaying a Vess Family Crest from England;⁴⁰ a page from the website at houseofnames.com discussing the “Vess” surname’s history;⁴¹ a page from the website at lastnames.myheritage.com discussing the “Vess” surname’s history;⁴² and a Wikipedia entry regarding the Urban Dictionary.⁴³

³⁵ September 29, 2021 Subsequent Final Office Action at TSDR 1.

³⁶ *Id.* at TSDR 2-25.

³⁷ *Id.* at TSDR 26-28.

³⁸ *Id.* at TSDR 29-34.

³⁹ *Id.* at TSDR 35-37.

⁴⁰ *Id.* at TSDR 38.

⁴¹ *Id.* at TSDR 39.

⁴² *Id.* at TSDR 40.

⁴³ *Id.* at TSDR 41-42.

The Board then resumed the appeal, and allowed Applicant to file a reply brief within 20 days of the corrected resumption order. 33 TTABVUE 1. Applicant did not do so.

The Board subsequently suspended the appeal “to give Applicant the opportunity to request a remand to claim registration of its proposed mark on the basis of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), in the alternative, if the Board does not reverse the surname refusal.” 35 TTABVUE 2. After recounting the history of the appeal to date, the Board explained that “Applicant never asserted a Section 2(f) claim in the alternative during prosecution in the manner discussed in [Trademark Manual of Examining Procedure] Section 1212.02(c), but language in its two appeal briefs suggests that Applicant believes, incorrectly, that its Section 2(f) claim of acquired distinctiveness remains an alternative basis for registration of its proposed mark if the surname refusal is not reversed.” *Id.* at 8. The Board suspended the appeal to give “Applicant the chance to properly make such a claim through further examination of its application if that is its intention” through a “request to remand the application to the Examining Attorney for consideration of a claim of distinctiveness under Section 2(f) in the alternative based on the evidence of record.” *Id.* at 9.

Applicant timely filed such a request “to claim registration for VESS on the basis of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1053(f) [sic], in the alternative, if the Board does not reverse the surname refusal.” 36 TTABVUE 2. Applicant stated that its claim “pursuant to § 2(f) in the alternative

does not constitute a concession that [the] matter sought to be registered is not inherently distinctive.” *Id.*

The Board then remanded the application to the Examining Attorney to “consider Applicant’s claim of acquired distinctiveness under Section 2(f) based on the evidence of record,” 37 TTABVUE 1, and the Examining Attorney determined in another Final Office Action that “Applicant’s claim of acquired distinctiveness is acceptable.”⁴⁴ She noted, however, that Applicant “does not concede that the matter sought to be registered is not inherently distinctive,” and that “the issue raised in the subsequent final Office action dated September 29, 2021 remains outstanding,” and she maintained and continued the surname refusal to register.⁴⁵

The appeal is hereby resumed, and it is now ready, at long last, for final decision.

II. Analysis of Surname Refusal

Section 2(e)(4) of the Trademark Act, 15 U.S.C. § 1052(e)(4), prohibits registration on the Principal Register of a mark that is “primarily merely a surname” unless the mark has acquired distinctiveness under Section 2(f). “A mark is primarily merely a surname if the surname is the primary significance of the mark as a whole to the purchasing public.” *In re tapio GmbH*, 2020 USPQ2d 11387, at *8 (TTAB 2020) (quoting *Earnhardt v. Kerry Earnhardt, Inc.*, 864 F.3d 1374, 123 USPQ2d 1411, 1413 (Fed. Cir. 2017)). “[T]here is no rule as to the kind or amount of evidence necessary to show that the applied-for mark would be perceived as primarily merely a

⁴⁴ May 11, 2022 Final Office Action at TSDR 1.

⁴⁵ *Id.*

surname[.]” and “[t]his question must be resolved on a case-by-case basis.” *Id.* (citing *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985)). We must “examine the entire record to determine the primary significance of” Applicant’s proposed mark VESS. *Id.*

There are multiple sources of evidence that may be probative of the possible surname significance of a proposed mark. The Board has often used a set of inquiries originating in *In re Benthin Mgmt. GmbH*, 37 USPQ2d 1332 (TTAB 1995), including (1) the degree of a surname’s rareness; (2) whether anyone connected with the applicant has that surname; (3) whether the term has any recognized meaning other than that of a surname; (4) whether the proposed mark has the “structure and pronunciation” of a surname; and (5) whether the stylization of lettering is distinctive enough to create a separate commercial impression. *tapiro*, 2020 USPQ2d 11387, at *9 n.28 (citing *Benthin*, 37 USPQ2d at 1333-34).⁴⁶ “These inquiries are not exclusive, and any of these circumstances—alone or in combination—and any other relevant circumstances may be considered when making this determination.” *Id.*, at *9 (citing *In re Eximius Coffee, LLC*, 120 USPQ2d 1276, 1277-78 (TTAB 2016); *In re Adlon Brand GmbH*, 120 USPQ2d 1717, 1719 (TTAB 2016)). We will consider each applicable source of evidence of surname significance discussed in *Benthin* and the Board’s subsequent cases under Section 2(e)(4).

⁴⁶ “Where, as here, the mark is in standard characters, it is unnecessary to consider the fifth factor.” *tapiro*, 2020 USPQ2d 11387, at *9 n.28 (citing *In re Yeley*, 85 USPQ2d 1150, 1151 (TTAB 2007)).

A. The Extent to Which “Vess” is Encountered as a Surname

“First, we consider the frequency of, and public exposure to, [VESS] as a surname . . . keeping in mind that “[t]he relevant question is not simply how frequently a surname appears . . . but whether the purchasing public for Applicant’s services is more likely to perceive Applicant’s proposed mark as a surname rather than as anything else.” *tapiro*, 2020 USPQ2d 11387, at *9 (internal citation omitted) (quoting *In re Beds & Bars Ltd.*, 122 USPQ2d 1546, 1551 (TTAB 2017)).

Applicant argues that “VESS as used as [a] surname is rare – according to the examiner’s office action LEXISNEXIS surname database could only find 2090 instances where VESS has been used as a surname” 24 TTABVUE 12.⁴⁷ The Examining Attorney also made of record data from the United States Census Bureau stating that “Vess” was the surname of almost 2,300 persons in the United States as of the 2010 Census, and was tied with some other surnames as the 13,397th most common surname in the United States out of 162,253 total surnames.⁴⁸

The Examining Attorney also made of record online articles, webpages, and pages from Wikipedia and LinkedIn, that refer to, and in many instances also show, persons with the surname “Vess” who are identified as living, or having lived, somewhere in

⁴⁷ Applicant appears to cite the Examining Attorney’s initial office action, to which the referenced evidence from the LEXISNEXIS surname database was not attached. August 12, 2018 Office Action at TSDR 1. Because Applicant accepted and addressed the stated figures, we will consider the evidence to be of record.

⁴⁸ September 29, 2021 Subsequent Final Office Action at TSDR 37. The Examining Attorney also made of record a “Vess Surname Distribution Map” stating that as of 2014 there were 2,864 persons in the United States with the surname “Vess,” and that the “Vess” surname ranked 13,247th in frequency in the United States. *Id.* at TSDR 29-34.

the United States, including in Michigan, North Carolina, South Carolina, Arizona, California, Florida, Kansas, Texas, Tennessee, Massachusetts, Virginia, Connecticut, Oregon, Alabama, Georgia, Washington, Colorado, Maryland, Rhode Island, Hawaii, Ohio, West Virginia, and Mississippi.⁴⁹

Applicant argues that these materials are “hearsay evidence” that show only that “the Examiner really had to dig deep to find use of VESS as a surname by non-mainstream media for not very ‘widely recognized public personalities.’” 24 TTABVUE 14. Applicant claims that “[n]one of the persons that [sic] Examiner identified that purportedly have a surname VESS are so notable or prominent that the relevant consuming public would view Applicant’s **four letter acronym mark** for Applicant’s Goods [sic] and Services and shown in the specimens and Applicant’s advertising materials is [sic] primarily merely a surname.” *Id.* (emphasis supplied by Applicant).

These arguments are unavailing for two reasons. First, the Federal Rules of Evidence, which define hearsay and govern when it is and is not admissible at a hearing or trial, Fed. R. Civ. P. 801-07, “do not apply in ex parte appeals,” *In re Medline Indus., Inc.*, 2020 USPQ2d 10237, at *3 (TTAB 2020), although they may be used as guidelines for the Board’s consideration of evidence. *Id.* (discussing the taking of judicial notice in ex parte appeals). Even if the Rules applied, however, the Examining Attorney’s evidence is not hearsay because we do not consider it for the

⁴⁹ December 31, 2020 Final Office Action at TSDR 10-25; September 29, 2021 Subsequent Final Office Action at TSDR 2-25.

truth of its contents (i.e., that “in 2013 Anna Vess was a 5-8 Goalkeeper and Redshirt Sophomore at Eisenhower Highschool [sic] that played one game in that season” or that “Virgil Lee Vess was born on August 1, 1939 and passed away on Friday July 22, 2011,” 24 TTABVUE 13), but only for what appears on the face of the materials, namely, that the public was exposed to the use of “Vess” as someone’s surname. *See* Fed. R. Evid. Rule 801(c) (defining “hearsay” as a statement that the declarant “does not make while testifying at the current trial or hearing” that is offered “to prove the truth of the matter asserted in the statement.”).

Second, contrary to Applicant’s suggestion that the Examining Attorney is required to show that persons with the surname “Vess” are “widely recognized public personalities,” or are “notable or prominent,” 24 TTABVUE 14, the Board has “decline[d] to adopt a heightened standard requiring ‘celebrity status,’ ‘national notoriety,’ or ‘significant media attention’ to find that a surname, although not common, has sufficient public exposure to the primarily merely a surname within the meaning of Section 2(e)(4) of the Trademark Act.” *tapio*, 2020 USPQ2d 11387, at *10. The Examining Attorney’s evidence regarding people named “Vess” shows that “the purchasing public is exposed to the [VESS] surname,” *id.*, even if the record does not show that any of the specific persons are celebrities or have achieved widespread exposure.⁵⁰

⁵⁰ Although it is not required in surname cases, evidence of national notoriety or celebrity status may be probative of surname significance where a surname is extremely rare. *See Beds & Bars*, 122 USPQ2d at 1551 (finding that the “rare surname BELUSHI is so well-known as a result of media publicity” regarding the late comedian John Belushi and his brother Jim Belushi “that it would be immediately recognized as a surname”); *In re Gregory*, 70 USPQ2d 1792, 1794-95 (TTAB 2004) (ROGAN found to be primarily merely a surname, even though

As noted above, Applicant also argues that “Vess” is a rare surname. 24 TTABVUE 12. The Examining Attorney responds that “the evidence of record establishes that individuals with the surname VESS routinely appear in the media and online” and that “[t]herefore, the surname is not rare and its primary significance to consumers is that of a surname.” 26 TTABVUE 8. Although any “strictly numerical approach to a surname analysis has been squarely rejected,” *Adlon*, 120 USPQ2d at 1721 (citing *Darty et Fils*, 225 USPQ at 653), the Board’s cases suggest that a surname is appropriately characterized as “rare” when its frequency among the United States population is far lower than that of “Vess.” See, e.g., *Beds & Bars*, 122 USPQ2d at 1551 (evidence that only five people in the United States had the surname “Belushi” “establish[ed] that it is an exceedingly rare surname”); *Eximius Coffee*, 120 USPQ2d at 1280-83 (the record showed that “Aldecoa” was “a surname, but one that is rarely encountered by the consuming public,” where it appeared only 233 times in the 2000 U.S. Census); *Adlon*, 102 USPQ2d at 1720-21 (the examining attorney’s evidence that “Adlon” was the surname of “approximately 75 individuals in the United States” demonstrated that “ADLON is a surname, albeit a rare one”); *Yeley*, 85 USPQ2d at 1151-52 (evidence that the surname “Yeley” appeared 147 times in the nationwide LEXISNEXIS phone directory supported a finding that it “is a rare surname.”);⁵¹ cf.

it was listed in telephone directories as the surname of slightly more than 1,000 persons in the United States, because of media coverage of former Congressman and USPTO Director James Rogan and others with the surname). As discussed below, the surname “Vess” is not nearly as rare as the surnames in *Beds & Bars* and *Gregory*.

⁵¹ Applicant tries to distinguish *Beds & Bars*, *Eximius Coffee*, *Adlon*, and other cases in which the Board affirmed refusals to register rare surnames, as well as the Federal Circuit’s decision in *Darty et Fils* to the same effect, on the ground that no one named “Vess” is associated with Applicant and in “most of those cases,” the fact that someone associated with

tapio, 2020 USPQ2d 11387, at *9-10 (“Tapio” found to be “not a common surname” where it ranked 65,244th in frequency in the 2010 Census); *Six Continents*, 2022 USPQ2d 135, at *11 (“Atwell” found to be “hardly a common surname” where it ranked 4,116th in frequency in the 2010 Census).

In the final analysis, however, whether or not “Vess” is a “rare” surname is of little importance because “[e]ven a rare surname may be held primarily merely a surname if its primary significance to purchasers is that of a surname.” *tapio*, 2020 USPQ2d 11387, at *10 (citing *Beds & Bars*, 122 USPQ2d at 1551). “Section 2(e)(4) makes no distinction between rare and commonplace surnames . . . and even a rare surname is unregistrable if its primary significance to purchasers is a surname.” *Id.* (quoting *Eximius Coffee*, 120 USPQ2d at 1281). “While hardly a common surname, [Vess] is not so rarely encountered that consumers would fail to recognize it as a surname.” *Six Continents*, 2022 USPQ2d 135, at *9. The Examining Attorney’s evidence “supports a finding that [VESS] is likely to be perceived by the public as a surname.” *tapio*, 2020 USPQ2d 11387, at *11.

the applicant had the surname weighed “very heavily.” 24 TTABVUE 16. As discussed below, however, the “the fact that no one named [Vess] is associated with Applicant does not tend to establish, one way or the other, whether consumers will perceive the proposed mark as a surname.” *In re Six Continents Ltd.*, 2022 USPQ2d 135, at *11 (TTAB 2022) (citing *tapio*, 2020 USPQ2d 11387, at *11; *Gregory*, 70 USPQ2d at 1795). The sources of evidence of possible surname significance “are not exclusive, nor are they presented in order of importance; any of the inquiries—singly or in combination—as well as any other relevant circumstances, may shape the analysis in a particular case.” *Id.*, at *5. “In making our determination, we weigh the inquiries together and accord the appropriate weight to each one based on the evidence of record.” *Id.*

B. Whether Anyone Connected With Applicant Has “Vess” as a Surname

Mr. Carrillo stated that there is no one connected to Applicant who has “Vess” as a surname,⁵² but “the fact that no one named [Vess] is associated with Applicant does not tend to establish, one way or the other, whether consumers will perceive the proposed mark as a surname.” *Id.*, at *11. “To be clear, the lack of evidence that a person associated with an applicant has the surname at issue is not probative of whether consumers perceive the term as a surname,” while “evidence that someone associated with an applicant has that surname can be probative that consumers perceive the term as a surname.” *Id.*, at *12 n.22. “This inquiry is neutral.” *Id.*, at *12.

C. Whether “Vess” Has a Non-Surname, “Ordinary Language” Meaning

The Examining Attorney made of record the results of searches of four online dictionaries showing that there were no definitions of the word “vess,”⁵³ or defining “Vess” as a surname whose frequency rank in the United States is 12,294,⁵⁴ or as a surname that is “[p]robably a respelling of German Wess.”⁵⁵ The Examining Attorney

⁵² February 27, 2019 Petition to Revive at TSDR 8 (Carrillo Decl. ¶ 13).

⁵³ March 30, 2019 Office Action at TSDR 2-5 (wordnik.com), 6-7 (dictionary.com); December 31, 2020 Final Office Action at TSDR 3 (OXFORD ENGLISH DICTIONARY (lexico.com)), 4 (MERRIAM-WEBSTER DICTIONARY (merriam-webster.com)).

⁵⁴ March 30, 2019 Office Action at TSDR 8 (rhymezone.com), 9 (lookwayup.com).

⁵⁵ September 29, 2021 Final Office Action at TSDR 26-28 (DICTIONARY OF FAMILY NAMES).

also made of record the results of a search of THE COLUMBIA GAZETTEER OF THE WORLD, which returned no results for “Vess” as a place name.⁵⁶

In its motion to remand after the filing of its supplemental brief, Applicant made of record pages from the Urban Dictionary (urbandictionary.com) that define “vess” variously as “[w]hen a woman is aroused by mental or physical stimulation and has a rush of blood and hormones to her clitt [sic];” “to investigate someone or something; an investigation;” and “ugly, sick, gross, [a] derogatory term that came from off a pop bottle outside an ice rink; an alternative to haggard.” 29 TTABVUE 5-7.⁵⁷ The Urban Dictionary is “a slang dictionary with definitions submitted by visitors to the website,” and although the Board has considered definitions from it, the Board has “recognize[d] the inherent problems regarding the reliability of Urban Dictionary because it is a collaborative website that permits anyone to submit or edit a definition.” *In re Star Belly Stitcher, Inc.*, 107 USPQ2d 2059, 2061 n.3 (TTAB 2013). “Urban Dictionary entries suffer from the same potential reliability problem that the Board has confronted with respect to Wikipedia,” *id.*, and the Board “will consider dictionary definitions taken from Urban Dictionary so long as the non-offering party has an opportunity to rebut that evidence by submitting other definitions that may call into question the accuracy of the particular Urban Dictionary definitions.” *Id.*

⁵⁶ December 31, 2020 Final Office Action at TSDR 2.

⁵⁷ In its motion, Applicant argued that “as set forth in Applicants’ [sic] reply brief the Board may take judicial notice of these facts not reasonably in dispute, including the definitions from the Urban Dictionary.” 29 TTABVUE 3 n.2. As noted above, Applicant received an initial extension of time to file a reply brief, 28 TTABVUE 1, and was allowed additional time to file one following the second remand of the application. 33 TTABVUE 1. Perhaps Applicant intended to file a reply brief or believed that one had been filed, but none was ever filed.

The Board also noted that “the better practice with respect to such evidence is to corroborate the information with other reliable sources if available.” *Id.*

Applicant did not corroborate the three Urban Dictionary definitions of “vess” with other evidence, and on remand after Applicant’s motion to remand was granted, the Examining Attorney made of record a Wikipedia entry regarding the Urban Dictionary, which states that “[b]y default, each definition is accepted or rejected based on the number of ‘Publish’ or ‘Don’t Publish’ votes it has received from volunteer editors.”⁵⁸ The Examining Attorney noted that Applicant’s screenshots from the Urban Dictionary “show that the sexual arousal definition only received 14 ‘Publish’ votes from volunteer editors, while the pop bottle definition received 3 ‘Publish’ votes and the investigation definition received 26 ‘Publish’ votes,”⁵⁹ and argued that “it appears these definitions only hold meaning for a very small and select group of people, and this evidence does not indicate that the public at large understands or recognizes any of these definitions.”⁶⁰

We agree with the Examining Attorney that Applicant’s Urban Dictionary evidence does not show that “vess” has an “ordinary language” meaning of the sort that would be reflected in a standard dictionary of American English. In that regard, “[n]either the MERRIAM-WEBSTER DICTIONARY (merriam-webster.com) nor THE

⁵⁸ September 29, 2021 Final Office Action at TSDR 42.

⁵⁹ *Id.* at TSDR 1. This is apparently a reference to the “thumbs up” and “thumbs down” icons on the Urban Dictionary pages in the record. Those icons reflect that 14 out of 15 volunteer editors were “thumbs up” on the sexual definition of “vess” and 26 out of 34 were “thumbs up” on the “investigation” definition, but that only three out of 36 were “thumbs up” on the “pop bottle” definition. 29 TTABVUE 5-7.

⁶⁰ December 31, 2020 Final Office Action at TSDR 1.

COLUMBIA GAZETTEER OF THE WORLD (columbiagazeteer.org) has definitions or listings for [“vess”],” *Six Continents*, 2022 USPQ2d 135, at *10-11, and “[w]here, as here, there is evidence that the mark at issue is a surname and that it is not a term defined in a [conventional] dictionary, such a circumstance tends to support a finding that the primary significance of [VESS] is as a surname.” *tapio*, 2020 USPQ2d 11387, at *11 (citing *Eximius Coffee*, 120 USPQ2d at 1280 (internal citations omitted)).

Applicant also suggests that “Vess” has non-surname “ordinary language” meanings based on the claimed meaning of the term as “a fanciful term adopted by Applicant,” specifically, as an acronym for the Spanish phrase “Vida Equilibrada Sentido y Sabiduría,” 24 TTABVUE 12, and evidence of the use of “Vess” and similar words by Applicant and third parties.

There is no evidence that United States consumers are familiar with the Spanish-language phrase “Vida Equilibrada Sentido y Sabiduría,” much less with the claimed abbreviation “Vess.” There is nothing on Applicant’s specimen of use, a page from its website,⁶¹ to indicate that “Vess” is an acronym for “Vida Equilibrada Sentido y Sabiduría.”⁶² Another page from Applicant’s website states that “VESS means Meaningful Life with Balance and Wisdom,” and that “VESS is a Visionary Educational Model that brings together the best educational programs around the word harmoniously integrated with ours and the PEP methodology (Thinking as a

⁶¹ April 12, 2018 Application at TSDR 1.

⁶² *Id.* at TSDR 26.

Pedagogical Strategy).”⁶³ On its face, VESS obviously does not abbreviate the English phrases “Meaningful Life with Balance and Wisdom” and “Visionary Educational Model,” and, as with Applicant’s specimen, there is nothing on the rest of its website that suggests that VESS abbreviates “Vida Equilibrada Sentido y Sabiduría.”

“[T]he record does not reflect that Applicant expressly promotes the significance of [VESS] as an abbreviation for [“Vida Equilibrada Sentido y Sabiduría”] so that the purchasing public would perceive [VESS] as such.” *tapio*, 2020 USPQ2d 11387, at *11-12 (rejecting the applicant’s argument that TAPIO abbreviated “tap” and “input/output” (“I/O”)). There is simply “nothing of record to suggest that this derivation [of VESS] would be recognized.” *In re Petrin Corp.*, 231 USPQ 902, 904 (TTAB 1986) (rejecting the applicant’s argument that PETRIN “is actually derived from and represents an abbreviated contraction of ‘petroleum’ and ‘insulation.’”).

Applicant’s evidence regarding third-party marks is equally unpersuasive.⁶⁴ Applicant made of record a single registration of VESS for “soft drinks and concentrates and syrups for making soft drinks,” which issued on the Principal Register on the basis of the registrant’s showing of acquired distinctiveness under Section 2(f) of the Trademark Act.⁶⁵ Applicant did not make of record the file history

⁶³ January 28, 2020 Request for Reconsideration at TSDR 28.

⁶⁴ Applicant made of record multiple third-party registrations of the mark VES for various goods and services, 24 TTABVUE 7-8, which Applicant argues show that the “marks VES and VESS are more likely viewed by consumers as acronyms than as surnames.” *Id.* at 17-18. The proposed mark here is VESS, not VES, and the multiple registrations of VES have no probative value on whether VESS would be perceived as an acronym.

⁶⁵ *Id.* at TSDR 68-69. Applicant made of record a Wikipedia entry regarding Vess Soda, 29 TTABVUE 9, which states that the VESS mark was based on the nickname of the registrant’s founder, Sylvester Jones. *Id.*

of this registration, but its issuance under Section 2(f) indicates that the USPTO did not consider VESS to be inherently distinctive. Applicant also made of record third-party uses of VESS as an abbreviation of “Vascular and Endovascular Surgery Society” on the Society’s website, 29 TTABVUE 11-22; as an abbreviation of “Virtual engine sound system” on the website of Texas Instruments, *id.* at 24-25; as the name of a model series of a storage appliance on the website of Promise Works, *id.* at 27-30; as an abbreviation of “Virtual Enterprise System Solutions” on the website of VESS Inc., *id.* at 32-33; and as an internal abbreviation of “Virtual EUROSIM Simulation Seminar,” described as a “series of online presentations discussing trends in modeling, simulation and forecasting,” on the website at eurosim.info. *Id.* at 35-41.

This handful of proprietary and shorthand uses of VESS does not establish that “Vess” has an ordinary language meaning with which United States consumers would be familiar that is more prominent than its meaning as a surname. “As a result, we cannot conclude that the primary significance of [VESS] to the purchasing public would be the abbreviation [of “Vida Equilibrada Sentido y Sabiduría”] or . . . something other than a surname.” *tapio*, 2020 USPQ2d 11387, at *12.

This inquiry, which considers whether a term has a non-surname, “ordinary language” meaning, “weighs in favor of affirming the surname refusal.” *Id.*

D. Whether “Vess” Has the Structure and Pronunciation of a Surname

The Board recently explained that “[s]ome names, by their very nature, have only surname significance even though consumers rarely encounter them,” while “consumers may encounter certain surnames that do not have the appearance of

surnames” and, in the latter “cases, even in the absence of non-surname significance, a reasonable application of the ‘primary significance to the purchasing public’ test could result in a finding that the surname, when used as a mark, would be perceived as arbitrary or fanciful.” *Six Continents*, 2022 USPQ2d 135, at *12-13. The Board gave PIRELLI and PETRIN as examples of rare surnames that “look like surnames,” *id.* at 12 (citing *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564 (TTAB 1988) and *Petrin*), and HACKLER and BAIK as examples of surnames that did not have the “look and feel” of a surname. *Id.*, at *13 (citing *In re United Distillers plc*, 56 USPQ2d 1220 (TTAB 2000) and *In re Joint-Stock Co. “Baik,”* 84 USPQ2d 1521 (TTAB 2007)).

The Board has acknowledged that “[a]ssessing whether [a term] has the structure and pronunciation of a surname is a ‘decidedly subjective’ inquiry.” *Id.*, at *13 (quoting *Benthin*, 37 USPQ2d at 1333). In connection with that inquiry, “[a]pplicants and examining attorneys may submit evidence that, due to a term’s structure or pronunciation, the public would or would not perceive it to have surname significance.” *Id.* “Pertinent evidence typically consists of other common surnames that are configured similarly and sound similar to the proposed mark.” *tapio*, 2020 USPQ2d 11387, at *12.

The Examining Attorney made of record and discusses evidence directed to this inquiry, 26 TTABVUE 9-10, while Applicant simply argues that it “does not use VESS as a surname and does not use it in conjunction with other given names or in a manner that would suggest it is a surname.” 24 TTABVUE 12.

The Examining Attorney made of record pages from ancestry.com regarding the surnames “Vess,” “Hess,” “Ness,” “Bess,” “Gess,” and “Ress,” and pages from the LEXISNEXIS Public Records database containing telephone listings for persons with the surnames “Hess,” “Ness,” “Bess,” “Gess,” and “Ress.”⁶⁶ These five surnames have the same four-letter, one-syllable structure as “Vess,” and when they are pronounced they are quite similar in sound to “Vess.” They suggest that “Vess” has the structure and pronunciation of a surname. *Cf. Adlon*, 120 USPQ2d at 1734 (rejecting the examining attorney’s argument that ADLON had the structure and pronunciation of a surname based on comparisons to “other purported surnames that have two syllables and end in LON or ON, like Dillon, Kaplon, Hanlon, Yelon, Ablon, Scanlon, Fallon, Kellon, Freelon, Nealon, Allon, Millon, Kallon, Donlon, Carlon, Dalton, Wilson, Acton, and Burton,” because “[w]ith the possible exception of Ablon and Allon, which differ from ADLON by one letter, the surnames cited are not highly similar in structure to ADLON” and “evidence showing that the surnames cited are similar in sound is lacking.”)⁶⁷ The Examining Attorney’s evidence of other similar surnames

⁶⁶ March 30, 2019 Office Action at TSDR 10-33; December 31, 2020 Final Office Action at TSDR 5-9. The surnames “Hess” and “Bess” had 108,747 and 19,435 “hits,” respectively, in the LEXISNEXIS telephone directory, *id.* at 5, 7, suggesting that they are more common in the United States than “Vess.”

⁶⁷ Applicant argues that the Examining Attorney’s argument based on this evidence “ignores many words [that] end in ESS, e.g. LESS, MESS, FULLNESS, CLUELESS, WELLNESS, DIFFERENTNESS, SUBSTANCELESS, etc.,” “ignores that VESS is a fanciful term adopted by Applicant, [and] ignores the other registered marks and words that end in -ESS, and the substance of the Applicant’s advertising.” 24 TTABVUE 12. These arguments completely miss the mark. The words LESS and MESS are closest in structure and pronunciation to VESS, but unlike VESS, they are both common English words that would not be viewed as surnames. The other words that “end in ESS” and that also appear in the dictionary are obviously entirely dissimilar in structure and pronunciation to VESS. We have rejected the

“leads us to conclude that Applicant's mark, [VESS], has the structure and pronunciation of a surname.” *tapio*, 2020 USPQ2d 11387, at *13.

E. Summary

The evidence relevant to three of the four applicable surname significance inquiries described in *Benthin* supports a finding that the primary significance of Applicant's proposed mark VESS to United States consumers is as a surname. “Vess” is unquestionably a surname that has been exposed to United States consumers, there is no other “common language” meaning of the word “vess” that could supplant its surname significance, and “Vess” has the structure and pronunciation of a surname. The fact that no one associated with Applicant has the surname “Vess” does not support, much less require, a contrary finding. We find, on the basis of the record as a whole, that Applicant's proposed mark is “primarily merely a surname” within the meaning of Section 2(e)(4) of the Trademark Act, and is thus ineligible for registration on the Principal Register in the absence of a showing of acquired distinctiveness.

Decision: The surname refusal to register is affirmed, but because Applicant has made a sufficient showing that its proposed mark has acquired distinctiveness under Section 2(f) of the Trademark Act, the application, as amended to seek registration on that basis, will be published for opposition.

factual premises of the rest of Applicant's arguments in our analysis above of other *Benthin* inquiries.